

## **REMARKS**

Claims 1-9 are in the case and presented for consideration.

At the outset, Applicant would like to thank the Examiner for the careful review of the application and for the indication of allowable subject matter.

Applicant has amended the specification and claims as suggested by the Examiner to better define the claimed invention and to overcome the Examiner's formality objections with respect to page 3, lines 8-11, of the specification and claims 1-5. Accordingly, the objections to the specification and claims are believed to be moot.

Claims 1, 4 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's acknowledged prior art in view of U.S. Patent 2,032,513 to Swart.

The Examiner states that prior art teach the overvoltage protection system as recited, for example, in claim 1, except for:

two gas capsule diverters (P1, P2) interconnected in series, wherein between the two gas capsule diverters a contact point is disposed and a switching configuration with an interrupter element (R10) for the interruption of current flowing across the gas capsule diverters is disposed between the contact point and a negative power terminal assumed to be ground. Interrupter element (R10) is a relay, the operation of which shunts and extinguishes gas capsule diverters (P1, P2). The operation of the interrupter element prevents permanent grounding of the gas capsule diverters, as disclosed by the reference. See Fig. 1; column 1, lines 38-40; and column 3, lines 31-42.

The Examiner states as motivation, that:

It would have been obvious... to use the configuration of the two gas capsule diverters interconnected in series with a switching configuration with an interrupter element disposed between them, as disclosed by Swart, in place of the single gas capsule diverter disclosed by the acknowledged prior art, in order to provide a means to extinguish and prevent permanent grounding of the gas capsules diverter after the occurrence of an overvoltage.

See pages 4-5 of the February 9, 2006 Office Action.

In response, Applicant respectfully traverses the above-noted rejection.

Applicant's claim 1 recites:

Anti-interference filter and lightning arrester device in a coaxial line for the transmission of high-frequency signals, comprising

a housing with two connectors, the housing forming an outer conductor connected to ground, an inner conductor carried through the housing, a connection between inner conductor and housing for the diverting of overvoltages and two gas capsule diverters in the connection between inner conductor and housing, characterized in that

in the connection between inner conductor and housing the two gas capsule diverters are interconnected in series,

between the two gas capsule diverters a contact point is disposed and a switching configuration with an interrupter element for the interruption of a current flowing across the gas capsule diverters is disposed between the contact point and the housing or ground.

The cited references do not disclose the features of claim 1 in the manner claimed.

To establish a *prima facie* case of obviousness, the initial burden is on the Examiner to show that there is suggestion or motivation in the reference for modifying or combining the teachings of the reference. See, e.g., MPEP § 2142. Prior art references must be considered as a whole, including portions that teach away from the claimed invention. *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It is inappropriate to use applicant's disclosure as a blueprint, or to use hindsight based on knowledge obtained from application's patent disclosure to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *In re Warner*, 379 F.2d

1011,1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057(1968); In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”).

See also the recent Federal Circuit case of *In re Kahn*, Fed. Cir. No. 04-1616, March 22, 2006. See full text at <http://pub.bna.com/ptcj/041616Mar22.pdf>. This case reiterates the requirement that for any obviousness rejection based on a combination of references, the rejection must **articulate the motivation** for combining the references.

The anti-interference filter and lightning arrester device, as recited in Applicant’s claim 1, is configured to ensure that the gas capsule diverter, after the suppression of an interference or overvoltage event and in spite of the presence of DC voltage and/or high frequency signals, changes from conducting to non-conducting state, ***even if the applied voltage is higher than the burning voltage of the gas capsule diverter***. The presence of additional DC voltage and/or high frequency signals is a problem which is not recognized or overcome by the cited references.

Swart shows an arrangement for simultaneously grounding a plurality of conductors (W1-W4). Each of these conductors is connected to a protector block, respectively a gas tube (P1-P4). However, these protector blocks are not series-connected. P1 belongs to W1, P2 to W2 and so on. The various components of the apparatus as taught by Swart are arranged to obtain a fixed operating voltage (see col. 1, line 42, to col. 2, line 7) and to switch the plurality of conductors (W1-W4) to ground if, for instance, conductor W1 is exposed to overvoltage (see col. 3, lines 11-16). The various gas discharge devices are extinguished by the operation of the transformer T (see col. 3, lines 21-28, stating that:

The only potential existing across the gas tube arrangements and conductors W1 to W4 after operation of relays R10 and R20 will be that due to the voltage drop in primary winding L1 of transformer T. This voltage will be but a few percent of that required to keep the glow present in the various gas discharge devices and hence these gas tubes will be extinguished),

and not by relays R1/R2 or R10/R20. This arrangement cannot solve the problem solved by the present invention. With this arrangement (of Swart), it is not possible to restore a single conductor to normal state, if for instance, additional high frequency signals is superimposed over the basic signals of the conductor.

In addition, the arrangement according to Swart is an active system. This means that a battery (B) is needed to operate the apparatus. In contrast, the device of the present invention is a passive system that does not require any additional power source to operate.

Furthermore, the arrangement according to Swart requires two groups of relays R10/R20, each respectively containing R1/R2/R3. In contrast, only one interrupter element (10) or relay is needed in the device, e.g., as recited in Applicant's claim 1, whereby a line (33) is connected to a contact point (8) between the two gas capsule diverters (6, 7).

The arrangement of the gas tubes (N/Z) is also not identical to structure recited in claim 1. As such, the arrangement of the gas tubes according to Swart cannot disclose or suggest the arrangement of the two gas capsule diverters in a manner that returns the gas capsule diverters to a non-conducting state after an overvoltage, even if the applied voltage is higher than the burning voltage of the gas capsule diverter.

Based on the foregoing, Applicant respectfully maintains that the cited references do not disclose or suggest the device as recited in Applicant's claim 1. The cited references also fail to provide the necessary motivation for combining the references in the manner proposed by the Examiner to arrive at the device as recited in Applicant's claim 1.

Accordingly, Applicant maintains that claim 1 recites patentable subject matter, and therefore, withdrawal of the rejection with respect to claim 1 is respectfully requested.

Claims 4 and 9 depend from claim 1, and therefore include the features of claim 1. Accordingly, for the same reasons given above for claim 1, claims 4 and 9 also contain patentable subject matter, and therefore, withdrawal of the rejection with respect to claims 4 and 9 is respectfully requested. No new matter has been added.

If any issues remain, the Examiner is respectfully invited to contact the undersigned to advance the application to allowance.

Respectfully submitted,

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